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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/082,678 | 02/25/2002 | Stewart L. Atkinson | 092246-9035-03 | 8406 |

23409 7590 08/08/2003

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EXAMINER

WILLSE, DAVID H

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3738

DATE MAILED: 08/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,678

Applicant(s)

ATKINSON ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 12, 25, 28, 45-47, 50 and 63-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 11, 13-24, 26, 27, 29-44, 48, 49 and 51-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: ____

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In the Information Disclosure Statement of February 26, 2003, certain references were not considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) or a complete copy (37 C.F.R. § 1.98(a)(2)) was not presented.

Claims 7-9, 12, 25, 28, 45-47, 50, and 63-111 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was apparently made **without** traverse in Paper No. 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 6, 10, 13-21, 26, 29-39, 41, 43, 44, 48, and 51-59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pusch, US 6,077,301, which discloses a pylon (including adaptor **30**), a prosthetic foot **10** and **11**, a prosthetic ankle **20**, and at least one link (comprising elements **90-93** and **34**). Regarding claim 19 and others: column 4, lines 22-24; Figure 1. Regarding claim 21 and others, the ankle **20** “may be made from a carbon composite” (column 4, line 53), and the pyramidal adaptor **30** is inherently of a more rigid material because of its intended function as an adjustable connector to upper portions of the leg prosthesis.

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Claims 4, 11, 22-24, 27, 40, 42, 49, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pusch, US 6,077,301. Regarding claim 4 and others, portions of the prosthetic ankle being substantially straight would have been an obvious step backward or a design simplification in order to fit with flat bottom pyramidal adaptors common in the art (in lieu of the less conventional adaptor 30) along with typical planar nuts and washers that could be used with the screw-bolt 26. Regarding claim 11 and others, an adjustment screw would have been obvious from column 3, lines 42-45. Regarding claim 22, prosthetic leg members of carbon-fiber composites were well known in the art and would have been obvious in view of their low weight and adequate strength, with the ordinary practitioner having been left to select an appropriate material; fiberglass materials were likewise commonly used for ankle and foot members and would have been an obvious alternative to a carbon composite in order to provide amputees with a broader range of choices for dynamic response characteristics. Regarding claims 23 and 24, split foot prostheses are well known in the art and would have been obvious from their disclosed advantages pertaining to improved gait performance, adaptability to rough terrain, etc.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attention is directed to the adjustment mechanisms illustrated in SU 311635 and SU 1519688 A1 and to the Achilles strap kit of the TALUX brochure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, who is available Monday through Thursday and whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse

August 5, 2003



DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738